

Notice of Allowability

Application No.

10/540,503

Applicant(s)

KAJIHARA ET AL.

Examiner

Layla Bland

Art Unit

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Applicant's amendment dated June 1, 2007.
2. ☒ The allowed claim(s) is/are 9-11, 14-16, 21 and 22 (now renumbered 1-8).
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date _____ |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date <u>6/1/2007</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

DETAILED ACTION

This office action is in response to applicant's amendment dated June 1, 2007, wherein claims 1-8, 12, 13, 17-20, and 23-28 are cancelled and claims 9-11, 14-16, 21 and 22 are amended. Claims 9-11, 14-16, 21 and 22 are examined on the merits herein.

The specification has been amended to denote trademarks in all capital letters.

The objection to claims 17 and 18 based on a misspelling has been rendered moot because those claims are cancelled.

The rejections of claims 1-8, 12, 13, 17-20 and 24-28 under 35 U.S.C. 103(a), and the rejection of claims 4 and 6 on the ground of nonstatutory obviousness-type double patenting are rendered moot because these claims have been cancelled. These rejections are withdrawn.

Claims 9-11 and 14-16 have been rewritten in independent form and such that the structures of the starting material and products are clearly different. Therefore the rejection under 35 U.S.C. 112, second paragraph, is withdrawn.

Reasons for Allowance

Claims 9-11, 14-16, 21 and 22 are currently pending and are examined on the merits herein.

The claimed methods preparation of asparagine-linked monosialooligosaccharide derivatives and the asparagine-linked oligosaccharide derivatives containing fluorine are

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adequately described in the specification in such a way as to enable one skilled in the art to practice the invention. Examples 1-7a, pages 60-72 of the specification, describe the methods of claims 9-11. Examples 8-49, pages 72-89 of the specification, describe the methods of claims 14-16 and the products of claims 21 and 22.

The claimed methods and products are not taught or fairly suggested by the prior art. Although fluorinated sialic acids and hydrolysis of sugar chains are known in the art, there is no teaching or suggestion to prepare the particular compounds which have been claimed. Thus the prior art does not anticipate or render obvious the claimed invention.

In view of the information discussed above, the indicated subject matter is allowable over the prior art.

Accordingly, Applicant's amendment dated May 1, 2007 is sufficient to remove all rejections made in the prior office action as discussed above and to place the application in condition for allowance.

Any comments considered necessary by Applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled, "Comments on Statement of Reasons for Allowance."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Bland whose telephone number is (571) 272-9572. The examiner can normally be reached on M-R 8:00AM-5:00PM UST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Anna Jiang can be reached on (571) 272-0267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Layla Bland
Patent Examiner
Art Unit 1623
July 3, 2007

Shaojia Anna Jiang

 7/3/07
Supervisory Patent Examiner
Art Unit 1623